

REMARKS

The non-final Office Action of November 20, 2002, has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 1-32 remain pending. New claims 33 and 34 have been added. Support for the added claims can be found in the specification and figures.

Rejections under 35 U.S.C. § 103(a)

Claims 1-32 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Adan et al. (U.S. Patent No. 6,373,047, hereinafter *Adan*) in view of Katrinecz, Jr. et al. (U.S. Patent No. 6,199,996, hereinafter *Katrinecz*). Applicants respectfully traverse these rejections and respectfully request reconsideration in view of the comments below.

Initially, Applicants note that the Action specifically cites as allegedly “being unpatentable over Adan et al. (USPN 6373047) in view of (USPN 6396477).” However, the corresponding remarks in the Action recite *Katrinecz* and cited portions of *Katrinecz*. Therefore, Applicants assume that the notation to “(USPN 6396477)” is a clerical error and the remarks will address the points raised in the Action in response to the *Katrinecz* reference. In the event that a different reference was intended in the rejection and not described, Applicants respectfully request the reissuance of the non-final Office Action.

The Action alleges that *Adan* shows all the features of Applicants’ independent claim 1, but states that *Adan* does not teach an illumination member of an input device that changes states. To overcome this deficiency, the Action relies on col. 1, lines 10-15 and 55-57 of *Katrinecz* and contends that, “*Katrinecz* on the other hand teaches a data entry device including a mouse, which has a feature of illumination with various characteristics.” The Action continues to allege that, “[o]ne would have been motivated in view of the suggestion of *Katrinecz* that the illuminating feature is functionally equivalent to the desired illuminating member of the input device.”

Applicants' independent claims 1 and 28 both recite, among other features, "communicating with a computer input device having an illumination member to cause the illumination member to change states in response to the determining step." Contrary to the Action's assertion, the combination of *Adan* and *Katrinecz* fails to teach or suggest at least this feature of Applicants' independent claims 1 and 28.

Adan describes an input device that at best detects images on a surface. (Col. 2, line 61). More specifically, *Adan* relates to an input device for providing position information to a computer based on the movement of the input device. (Col. 1, lines 26-29). However, as admitted in the Action, *Adan* clearly fails to teach or suggest an illumination member. Further, *Adan* fails to teach or suggest communicating with a computer input device as claimed. *Adan* fails to teach or suggest transmission of information from the serial interface 46 to the mouse 42.

Katrinecz describes an illuminated keyboard/keypad that at best allows a user to set a desired intensity by use of a rheostat (col. 3, lines 56-59) or allows a keyboard to change its intensity in response to the darkness of the environment in which the keyboard is located (col. 3, lines 60-64). Although the keyboard has a luminescent sheet, any change in intensity of light illuminating from the keyboard is based *on a setting physically inputted by a user or an environmental response of a photocell*. Any change of light intensity in the *Katrinecz* keyboard is not in response to a determination in a computer. As shown in Figure 3B and 3C of *Katrinecz*, the intensity of the light is only controlled by the manipulation of a rheostat 85 by a user or a photocell 90 in response to an environmental condition.

Katrinecz fails to teach or suggest, "communicating with a computer input device having an illumination member to cause the illumination member to change states in response to the determining step," as recited, among other features, in Applicants' claims 1 and 28. Applicants submit that the Action has failed to identify any suggestion, incentive or motivation to combine the applied art at the time of the invention. In explaining that one skilled in the art would have modified *Adan* "to include *Katrinecz*'s illuminating feature," the Action merely asserts that, "the use of an illuminating feature in an input device helps to control visual attributes and

functionalities as taught by *Katrinecz*.” However, the Action’s reason for combining the references to attempt to obtain the claimed invention lacks merit. Namely, the Action has taken two unrelated patents and has attempted to combine features not found in either patent alone or in combination. In light of the foregoing, the combination of *Adan* and *Katrinecz* is improper and therefore does not render the claimed invention obvious. Therefore, Applicants submit that claim 1 distinguishes over the prior art of record and is in condition for allowance.

Further, even if improperly combined, the result of *Adan* and *Katrinecz* does not result in Applicants’ claims 1 and 28. As admitted by the Action, *Adan* does not specifically teach an illumination member of an input device that changes states. Additionally, *Adan* does not teach or suggest communication with an input device. Indeed, *Adan* is totally unrelated to illumination of an input device. *Katrinecz* requires a user to change the light intensity of a keyboard or the keyboard itself to change the light intensity based on its environment. Because *Katrinecz* requires a user to alter light intensity or the keyboard itself to alter light intensity in response to its environment, the combination of *Katrinecz* with *Adan* would require *Adan* to alter the function of *Katrinecz* in order to teach all the features of Applicants’ claims 1 and 28.

As already stated above, *Adan* describes an input device that at best detects images on a surface. (Col. 2, line 61). *Adan* does not teach or suggest communication with an input device. Neither *Adan* nor *Katrinecz*, either alone or in combination, teaches nor suggests “communicating with a computer input device having an illumination member to cause the illumination member to change states in response to the determining step,” as recited, among other features in Applicants’ claims 1 and 28. Thus, the Action has failed to provide a proper *prima facie* case of obviousness and the rejection is therefore respectfully traversed. Withdrawal of the rejection is respectfully requested.

Applicants’ independent claim 6 recites, among other features, “changing a state associated with the illumination member in response to the determination step.” Again, as stated above in reference to Applicants’ claims 1 and 28, contrary to the Action’s assertion, the combination of *Adan* and *Katrinecz* fails to teach or suggest at least this feature of Applicants’

independent claim 6. As already stated above, *Adan* describes an input device that at best detects images on a surface. (Col. 2, line 61). *Adan* does not teach or suggest communication with an input device as claimed. Neither *Adan* nor *Katrinecz*, either alone or in combination, teaches nor suggests “changing a state associated with the illumination member in response to the determination step,” as recited, among other features in Applicants’ independent claim 6. Thus, the Action has failed to provide a proper *prima facie* case of obviousness and the rejection is therefore respectfully traversed. Withdrawal of the rejection is respectfully requested.

Claims 2-5, 7-27, and 29-32 are dependent on claims 1, 6, and 28, respectively, and are believed to be allowable over the prior art for at least the above stated reasons and further in view of the additional advantageous features recited therein.

For example, the applied art does not provide a teaching or suggestion of, “causing the illumination member to blink,” as recited, among other features, in Applicants’ dependent claim 3. *Katrinecz* at best describes a keyboard that can have an illumination sheet with the intensity of light being illuminated from the keyboard dictated by a user or the environment of the keyboard. However, *Katrinecz* clearly does not teach or suggest, “causing the illumination member to blink,” as recited, among other features in Applicant’s claim 3.

Further, the applied art does not teach or suggest, “causing the illumination member to change colors,” as recited, among other features, in Applicants’ dependent claim 5. *Katrinecz* at best describes a keyboard that can have different colored illumination sheets placed under different sections of keys on the keyboard. (Col. 2, lines 19-21). Plainly, *Katrinecz* requires multiple illumination members, whether sheets or keys, each with a particular color associated with it. The same illumination sheet or illumination key cannot change color. *Katrinecz* clearly does not teach or suggest, “causing the illumination member to change colors,” as recited, among other features in Applicant’s claim 5.

In reference to Applicants’ claim 9, the Action cites *Adan*’s Figure 10B and reference elements 192 and 196. Applicants’ dependent claim 9 recites, among other features, “determining whether at least one e-mail message has been received.” Contrary to the Action’s

assertion, Figure 10B and reference elements 192 and 196 of *Adan* describe communication with an operating system 35 in a computer 20 and not an input device. Further, step 192 of *Adan* is a determination in response to a mouse message received from the mouse driver (step 190). The determination step 192 is in response to an image captured in a mouse (step 176) and not a determination as to whether at least one e-mail message has been received. *Adan* clearly does not teach or suggest, “determining whether at least one e-mail message has been received,” as recited, among other features in Applicant’s claim 9.

Further, in regards to Applicants’ claim 19, the Action cites Figure 3 of *Adan* as allegedly teaching the use of the input device with respect to game applications. Applicants’ claim 19 recites, among other features, “determining whether a correct answer has been input.” Figure 3 of *Adan* is described between col. 7, line 34 and col. 8, line 65. As stated in the specification, Figure 3 “is a more detailed diagram... illustrating an operator input device, such as mouse 42, in accordance with one embodiment of the present invention.” (Col. 7, lines 34-37). The cited Figure 3 of *Adan* describes nothing more than the internal components of a mouse 42. Clearly, neither the cited Figure 3 of *Adan*, nor any other portion of *Adan* or *Katrinecz*, either alone or in combination, teach or suggest a gaming environment or the step of, “determining whether a correct answer has been input,” as recited, among other features, in Applicants’ claim 19.


CONCLUSION

In view of the remarks above, Applicants respectfully submit that the instant application is in condition for allowance. If the Examiner feels, that further discussion may be helpful in facilitating prosecution of the case, the Examiner is respectfully requested to telephone the undersigned attorney of record at the telephone number appearing below.

Respectfully submitted,
BANNER & WITCOFF, LTD.

Date: February 12, 2003

1001 G Street N.W.
Eleventh Floor
Washington, D.C. 20001
(202) 824-3000

By: 
Robert S. Katz
Registration No. 36,402